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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,598	10/12/2004	Joseph P. Errico	SPINE 3.0-437	8307
51640	7590	10/18/2011	EXAMINER	
SPINE MP			PELLEGRINO, BRIAN E	
LERNER, DAVID, et al.				
600 SOUTH AVENUE WEST			ART UNIT	
WESTFIELD, NJ 07090			PAPER NUMBER	
			3738	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/784,598	<b>Applicant(s)</b> ERRICO ET AL.	
	<b>Examiner</b> BRIAN PELLEGRINO	<b>Art Unit</b> 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 1,3-5,7,12,13 and 15 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1,3-5,7,12,13 and 15 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☒ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Specification*

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the new limitation of “at least one of the two prongs forming a monolithic structure with the shaft...” was not found in the written disclosure.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,3-5,7,15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the “distal end of the shaft **bending in a direction toward** one of the group consisting of left and right relative to the longitudinal axis of the shaft” and also recites “at least one of the two prongs.....and *extending away from the longitudinal axis* of the shaft”. It is not clear if the prong extends away from the longitudinal axis that is considered as bending either left or right? The recitation that a prong extends away from the shaft can be in any direction, thus the distal end that “bends away” could be considered some other direction not the same as the prong direction. Thus, there would be multiple features at the distal end extending away and bending from the longitudinal

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axis. It is not clear that this arrangement is supported by the disclosure. Clarification is requested. Claims 3-5,7,15 are rejected for being dependent upon a rejected base claim.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3-5,7,15 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Foster (1425845) as evidenced by Zelgert (2546287). Foster discloses (Fig. 2) apparatus having a shaft **A** with a distal end and a longitudinal axis with the distal end bending toward a left direction relative the axis of the shaft. It can be seen that there are two pins **a<sup>1</sup>**,**b** coupled to the shaft distal end and being perpendicular to the longitudinal axis and parallel to each other. Additionally it can be seen that pin **a<sup>1</sup>** is located on the longitudinal axis of the shaft and pin **b** is located offset from the longitudinal axis of the shaft. Additionally, it can be seen the apparatus is fully capable of engaging a “body” that has at least two holes illustrated by element **C** which has holes therein. Please note the intended use carries no weight in the absence of any distinguishing structure. It can be interpreted that the prong that extends away or bends away from the longitudinal axis of the shaft is formed as a monolithic structure with the shaft since the sections are made as a single unit not meant to come apart. Zelgert teaches such a construction is known as monolithic, col. 3, lines 10-13. With respect to claim 3, the apparatus is fully

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capable of enabling rotation. Regarding claim 4, force is capable of being applied to the apparatus to extract an implant body. With respect to claim 5, an individual is capable of selecting holes to for a particular orientation of use. Regarding claim 7, Foster discloses the shaft end is lengthened and tapered forming a handle, col. 2, line 71.

Regarding claim 15, it can be seen Foster shows (Fig. 2) the distal end of the shaft has a first straight prong (**a**) extending along the longitudinal axis and a second curved prong (**B**) extending away from the longitudinal axis in a left or right direction.

Alternatively Foster discloses the claimed invention except for the prong that bends away from the shaft longitudinal axis being formed as a monolithic structure with the shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to monolithically form the bent away prong with the shaft, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Such a monolithic structure is capable of being formed with this tool as it can be designed in hinged fashion.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 12,13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foster '845 (as evidenced with Zelgert) in view of Ripple et al. (4566466). Foster discloses the claimed invention except for a set of apparatuses. It is noted that Foster

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shows (Fig. 2) that an apparatus has a first straight prong (**a**) extending along the longitudinal axis and a second curved prong (**B**) extending away from the longitudinal axis. Foster additionally illustrates (Fig. 2) that there is a pair of pins **a**<sup>1</sup>, **b** coupled to the shaft distal end and parallel with one another. It can also be said that the prong that extends away or bends away from the longitudinal axis of the shaft is formed as a monolithic structure with the shaft since the sections are made as a single unit not meant to come apart, see Zelgert explained above. Alternatively Foster discloses the claimed invention except for the prong that bends away from the shaft longitudinal axis being formed as a monolithic structure with the shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to monolithically form the bent away prong with the shaft, since it has been held that forming in one piece an article which has formerly been formed in tow pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893). Such a monolithic structure is capable of being formed with this tool as it can be designed in hinged fashion. Ripple et al. teach (Fig. 7) that apparatus or a tool for a specific procedure is provided in a set of apparatuses for the user. Ripple further teaches (col. 4, lines 38-47) that the set gives the user the ability to select a correct tool or instrument for the purpose of matching with the required dimension. It would have been obvious to one of ordinary skill in the art to provide a set of apparatuses by Foster using the teaching of Ripple et al. so that the user can have a tool or apparatus to engage with the body or implant element having holes to match appropriate dimensions. Because the individual components of applicant's claimed apparatus "for repositioning" set are

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known in the prior art, it would have been obvious to one of ordinary skill in the art at the time of the invention to have a plurality of these components available at the same time (i.e., as in a “set”), such as during a work procedure using the tool, so that the user can select the appropriately arranged and sized apparatus for the particular disc coupling with. Regarding claim 13, the apparatus is capable of being used in an anterior approach or an anterior-lateral approach.

### ***Response to Arguments***

Applicant's arguments filed 8/31/11 have been fully considered but they are not persuasive. In response to applicant's argument that the Foster reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the prong extending or bending away has a fixed position or is immovable relative to the shaft) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim limitations do not limit the bent away prong from being one that can “swing” and thus it can be said that Foster discloses the claimed invention as recited.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN PELLEGRINO whose telephone number is (571)272-4756. The examiner can normally be reached on M- F (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Thomas Sweet at 571-272-4761. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If there are any inquiries that are not being addressed by first contacting the Examiner or the Supervisor, you may send an email inquiry to TC3700\_Workgroup\_D\_Inquiries@uspto.gov.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TC 3700  
/Brian E Pellegrino/  
Primary Examiner, Art Unit 3738